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OFFICE OF PETITIONS

In re Application of :
KORSUNSKY, ALEXANDER M. : APPLICATION FOR PATENT
Application No. 10/502,432 : TERM ADJUSTMENT
Filed: July 25, 2005 :
Attorney Docket No. ISI-003US :

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(B)" filed May 5, 2010. Applicants submit that the correct patent term adjustment to be indicated on the patent is a minimum of nine hundred eighteen (918) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants seek this correction partly on the basis that the Office will take in excess of three years to issue this patent.

The request for reconsideration of the patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PALM and PAIR screens to reflect that the corrected patent term adjustment determination at the time of the mailing of the notice of allowance is **zero (0) days**. A copy of the updated PAIR screen, showing the corrected determination, is enclosed.

Initially, applicants disclose that they should have been assessed a period of delay of 504 day pursuant to 37 CFR 1.704(c)(3) for the abandonment of the application. The Office concurs with applicants.

37 CFR 1.704(c)(3) states:

Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed[.]

In this instance, a non-final Office action was mailed on July 24, 2007, which set a three-month shortened statutory period for reply. Applicants did not file a timely and proper reply to the non-final Office action. Thus, the application became abandoned on October 25, 2007. On December 17, 2008, applicants filed a petition under 37 CFR 1.137(b) to revive the application. A decision granting the petition to revive was mailed on March 11, 2009. Accordingly, the period of adjustment should be reduced by an additional 504 days, the number of days beginning on the date of abandonment, October 25, 2007, and ending on the lesser period of the date of mailing of the decision reviving the application, March 11, 2009. See 37 CFR 1.704(c)(3)(i). A period of reduction of 504 days will be entered.

As to applicants' request for reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined.

Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months

¹ For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

In view of the additional period of reduction pursuant to 37 CFR 1.704(c)(3), the patent term adjustment determination at the time of the mailing of the notice of allowance should be zero (0) days (322 days of Office delay - 504 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
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Enclosure: Copy of updated PAIR screen

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/502,432

Filing or 371(c) Date:	07-25-2005	Overlapping Days Between {A and B} or {A and C}:	0
Issue Date of Patent:	-	Non-Overlapping USPTO Delays:	322
A Delays:	322	PTO Manual Adjustments:	-504
B Delays:	0	Applicant Delays:	0
C Delays:	0	Total PTA Adjustments:	0

Patent Term Adjustment History Explanation Of Calculations

Number	Date	Contents Description	PTO (Days)	APPL (Days)	Start
75	10-20-2010	Adjustment of PTA Calculation by PTO		504	0
61	02-05-2010	Mail Notice of Allowance			0
60	02-02-2010	Notice of Allowance Data Verification Completed			0
59	01-30-2010	Document Verification			0
58	02-01-2010	Examiner's Amendment Communication			0
57	01-27-2010	Examiner Interview Summary Record (PTOL - 413)			0
56	02-01-2010	Notice of Allowability			0
55	01-07-2010	Date Forwarded to Examiner			0
54	12-09-2009	Response after Non-Final Action			0
53	09-09-2009	Mail Non-Final Rejection			0
52	09-08-2009	Non-Final Rejection			0
51	08-11-2009	Date Forwarded to Examiner			0
50	08-07-2009	Amendment after Final Rejection			0
49	05-07-2009	Mail Final Rejection (PTOL - 326)	20		46
48	05-07-2009	Final Rejection			0
47	04-16-2009	Date Forwarded to Examiner			0
46	12-17-2008	Response after Non-Final Action			0
45	03-11-2009	Mail Notice of Rescinded Abandonment			0

44	04-16-2009	Notice of Rescinded Abandonment in TCs		0
38	03-11-2009	Mail-Petition to Revive Application - Granted		0
37	03-11-2009	Petition to Revive Application - Granted		0
36	12-17-2008	Petition Entered		0
35	02-25-2008	Mail Abandonment for Failure to Respond to Office Action		0
34	02-19-2008	Aband. for Failure to Respond to O. A.		0
33	07-24-2007	Mail Non-Final Rejection	302	12
32	07-23-2007	Non-Final Rejection		0
25	06-19-2007	Case Docketed to Examiner in GAU		0
23	04-17-2006	Cleared by OIPE CSR		0
21	11-17-2005	IFW TSS Processing by Tech Center Complete		0
19	07-25-2005	Reference capture on IDS		0
12	07-25-2005	371 Completion Date		0
11	08-30-2005	Application Dispatched from OIPE		0
10	08-30-2005	Notice of DO/EO Acceptance Mailed		0
9	07-25-2005	Additional Application Filing Fees		0
7	07-25-2005	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic		0
6	08-18-2005	Mail-Petition Decision - Granted		0
5	07-25-2005	Petition Entered		0

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